08/472,065 (the '065 application); claims 141-148 of co-pending application 08/471,833 (the '833 application); claims 132-162 of co-pending application 08/735,021 (the '021 application); claims 132-133, 149-150, and 152 of co-pending application 08/470,339 (the '339 application); and claims 132-140 of co-pending application 08/736,070 (the '070 application).

In response to the double patenting rejection, Applicants point out that rejection of the present claims as obvious over claims 1 and 2 of the '096 patent is improper. The present application is a continuation of co-pending application 08/471,833 (the '833 application). The '833 application and the '096 patent (formerly co-pending application 08/472,008 {'008 application}) were both filed on June 6, 1995 as divisional applications of application 08/386,555 (now U.S. Patent 5,530,109, which was filed March 24, 1995 and issued June 25, 1996), after a restriction requirement was issued for the '555 application. Because the present application is a continuation of the '833 application and the claims fall within the same restriction group as the '833 claims (i.e., method of inducing myelination of a neural cell by a glial cell, comprising contacting said glial cell with an amount of recombinant polypeptide containing an EGF-like domain), Applicants do not believe that a terminal disclaimer is appropriate. See *In re Berg* CAFC, 97-1367, 3/30/98 (hereafter "Berg"). In Berg, the Federal Circuit stated that,

> If the claims are so restricted, one or more divisional applications can then be filed containing the claims that were the subject of restriction. When such a

> divisional application is filed, the PTO is prohibited from using the claims of the patent issuing on the application that prompted the restriction requirement as a reference against the claims of any divisional application. See 35 U.S.C.§ 121; see also MPEP § 804.01. Hence, by filing all its related claims in one application, such an applicant is protected from an obviousness-type double patenting rejection if the PTO later determines the applicant has submitted claims to more than one patentable invention.

In view of Berg, an obviousness-type double patenting rejection is improper when claims issuing from a divisional application are used to formulate a rejection against claims in a continuation of a second divisional application stemming from the same parent application, given that the restriction requirement necessitating the filing of divisional applications was issued in the parent application. Both the present application and the '833 application are in Restriction Group XI (methods for inducing myelination using the GGF protein in glial cells), whereas the '008 application was in Restriction Group XII (methods for inducing acetylcholine synthesis). These methods were deemed to be separate inventions by the Patent Office. Hence, a terminal disclaimer should not be required for the present claims.

Similarly, the provisional obviousness type-double patenting rejection is improper, because each of the applications on which the rejection is based are either divisional applications of the '555 application, or continuations of divisional applications of the '555 application, which all of the filings were necessitated by a restriction requirement in the U.S.P.N. 5,530,109. Specifically, the instant application is a continuation application of the '833 application, and the claims fall within the same restriction group as the '833

claims, the '833, '065 and '339 applications are divisional applications of the '555 application, and the '070 application is a continuation application of the '065 application, with claims falling within the same restriction group as the '065 claims. In view of these facts, the provisional double patenting rejection is improper, and Applicants request that this rejection also be withdrawn.

Conclusion

In view of the foregoing remarks, Applicants submit that the claims are in condition for allowance and such action is requested. If the Examiner does not cuncur with applicants analysis, a telephone interview with the undersigned is respectfully requested. Enclosed is a petition and a check to extend the period for replying for one month, to and including October 9, 1999. If there are any charges, or any credits, please apply them to Deposit Account No. 03-2095.

Respectfully submitted,

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